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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,412	08/30/1999	JEAN-MICHEL STURLA	5725.0470-01	9112
22852	7590	01/30/2002	EXAMINER BAWA, RAJ	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			ART UNIT 1616	PAPER NUMBER
DATE MAILED: 01/30/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/385,412	Applicant(s) Sturla et al.
Examiner Bawa	Art Unit 1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Nov 5, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-29 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-29 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) Other: _____

Detailed Action

The restriction requirement has been withdrawn.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 838211.

EP discloses hair mousse compositions containing polyurethane resin, propellants, secondary fixatives, etc. This composition can be delivered via an aerosol dispensor (claims, abstract). Hydroalcoholic solutions may be employed to solubilize these polyurethanes (page 3, line 16). Various preparative reactions for these urethanes are also disclosed. Various additional cosmetic ingredients claimed are

conventional to the hair art, ^{and} may also be included in the EP compositions. (page 8, lines 1-19). The amount of polyurethane claimed overlaps with that disclosed by EP (page 3, lines 1-6).

The applicant's claims are directed towards similar hair mousse compositions containing the ingredients disclosed by EP. EP lacks a specific disclosure of the flow rate claimed or the nozzle orifice dimensions of the aerosol delivery device.

It would be *prima facie* obvious to one of ordinary skill in the hair mousse art to manipulate the ratios of the EP ingredients (i.e., polyurethane, propellant, organic solvent) and obtain functional mousse with a foam rate claimed (EP, page 15, lines 24-31).

A skilled practitioner in the art would recognize that optimization of the component amounts is routine, since it is well known that discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233).

The synthesis of the polyurethanes of EP is similar to that claimed; though this is not relevant from a patentability point of view. "Even though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" [(See *In re Thorpe*, 227 U.S.P.Q. 964, 966 Fed. Cir. 1985)] "The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than

when a product is claimed in the conventional fashion. [See *In re Fessmann*, 180 U.S.P.Q. 324, 326 (CCPA 1974).]

Furthermore, note that delivery of the EP mousse as an aerosol propellant composition inherently requires delivery via a pressurized aerosol delivery device. The claimed delivery device is conventional, absent evidence to the contrary.

Moreover, there is no comparative data of record in this case that (i) presents any unexpected results over the closest prior art; or (ii) establishes any improvements over the closest prior art with respect to nozzle dimensions or flow rate. Note that: (i) the cited art is analogous because it pertains to the field of the inventor's endeavor and is also reasonably pertinent to the particular problem with which the inventor is involved. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992); (ii) a comprising-type language does not exclude other steps, elements or materials. *Cues Inc. vs. Polymer Industries*, U.S.P.Q. 2d 1847 (DC ND GA 1988) ; (iii) it is well established that the claims are given broadest interpretation during examination; (iv) a conclusion of obviousness under 35 U.S.C. 103(a) does not require absolute predictability, only a reasonable expectation of success; and (v) references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 U.S.P.Q. 545 (CCPA 1969).

In light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103(a).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raj Bawa whose telephone number is 703-308-2423. The examiner can normally be reached on Tuesday-Friday 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



RAJ BAWA, Ph.D.
PRIMARY EXAMINER

Bawa:mv
January 18, 2002